UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,666	12/28/2000	Frank Liebenow	257/020	4510

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EXAMINER
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ART UNIT	PAPER NUMBER
2153	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)
Office Action Summary		09/752,666	LIEBENOW, FRANK
		Examiner	Art Unit	
		Aaron Strange	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
> Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 December 2006*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,2,7-12,14,15,17,18,21-32,34 and 35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,2,7-12,14,15,17,18,21-32,34 and 35* is/are rejected.

7) ☒ Claim(s) *29* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   In the interest of expedited prosecution, the Examiner would like to extend an

invitation to Applicant to conduct an interview prior to filing a response to this action.

The Examiner feels that an interview could expedite prosecution of the present

application, and Applicant is encouraged to contact the Examiner to schedule an

interview if he/she agrees.

Response to Arguments

2.   Applicant's arguments with respect to claim 10 have been considered but are

moot in view of the new ground(s) of rejection.

3.   Applicant's arguments filed 12/11/06 have been fully considered but they are not

persuasive.

4.   With regard to claims 1,12,14 and 32, and Applicant's assertion that "the

requesting and storing steps do not occur 'at the same time' as required by the claim

language" (Page 10 of Remarks), it is noted that none of the present claims contain

such a limitation. While this limitation was proposed in the after-final response filed

10/11/2006, it was not entered. Rather, the current claims have been amended to state

that the requesting (obtaining) step occurs after the receiving step. Therefore,

Applicant's arguments are not persuasive and the newly added limitation has been

addressed below.

5.   With regard to claim 26, and Applicant's assertion that Mantha does not disclose

providing the user of the client system with an "option to delete an earlier version of the

received data being stored" (Page 15 of Remarks), the Examiner respectfully disagrees.

As discussed in the Office Action of 8/11/2006, Mantha discloses that the user may

delete "a saved Web page copy" (at least Col 9, Lines 38-49). Mantha places no

limitation on the saved copies that may be deleted. It would have been apparent to one

of ordinary skill in the art that the user could delete an earlier version of the web page

being stored, as well as any other stored web page.

Claim Objections

6.   The numbering of claims is not in accordance with 37 CFR 1.126 which requires

the original numbering of the claims to be preserved throughout the prosecution. When

claims are canceled, the remaining claims must not be renumbered. When new claims

are presented, they must be numbered consecutively beginning with the number next

following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 34 (the second one) been renumbered 35.

7.   Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 29 contains

substantially identical limitations to amended claim 1, and fails to further limit the claim.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   Claims 12 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

10.   Claim 12 recites the limitation "the obtaining step" in 12. There is insufficient

antecedent basis for this limitation in the claim. For the purpose of applying prior art, this

has been interpreted as "the entering step".

11.   Claim 12 recites the limitation "the retrieving step" in 12. There is insufficient

antecedent basis for this limitation in the claim. For the purpose of applying prior art, this

has been interpreted as "the browsing step".

12.   Claim 35 recites the limitation "the retrieving step" in line 2. There is insufficient

antecedent basis for this limitation in the claim. For the purpose of applying prior art, this

has been interpreted as "the receiving step".

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14.   Claims 1,2,7,8,14,15,17,18,21-26,29-31 and 32 are rejected under 35

U.S.C. 102(b) as being anticipated by Adams et al. (US 5,873,100).

15.   **With regard to independent claim 1**, Adams discloses a method comprising the

steps of:

receiving, by a client system, in response to a request by a user of the client

system, data from a network in a distributed system (Col 3, Lines 47-49 and 62-65);

obtaining, by said client system from the user of the client system, an indication

of a minimum length of time during which the received data is to be temporarily stored

(Col 3, Lines 22-26); and

storing temporarily on the client system at least a portion of the received data for

a period of at least the minimum length of time indicated by the user at the client system

(document remains a keep document for at least the time period and only non-keep

documents are deleted)(Col 3, Lines 66-67 and Col 4, Lines 3-4);

wherein the obtaining step is performed after the receiving step (documents

which are already received may be indicated as keep documents) (Col 3, Lines 18-20).

16.   With regard to claim 2, Adams further discloses that the received data is stored in

a memory space accessible by the client system as cache (Col 3, Lines 66-67).

17.   With regard to claim 7, Adams further discloses the step of designating, on said

client system, that the received data be temporarily stored (Col 3, Lines 25-28), wherein

the designating step includes a step of presenting a user with a window for user input

(Col 3, Lines 12-20).

18.   With regard to claim 8, Adams further discloses that the obtaining step is carried

out by a user in real time (time is obtained when document is indicated as a keep

document)(Col 3, Lines 18-20).

19.   With regard to claim 21, Adams further discloses inquiring of the user of the client

system whether the received data should be temporarily saved (Col 3, Lines 12-16 and

22-28).

20.   With regard to claim 22, Adams further discloses receiving an indication from the

user that the at least a portion of the received data is to be temporarily stored (user

designates a keep document) (Col 3, Lines 12-16 and 22-28).

21.   With regard to claim 23, Adams further discloses prompting the user of the client system to enter the minimum length of time to temporarily store the received data (keep documents may be time limited)(Col 3, Lines 22-28).

22.   With regard to claim 24, Adams further discloses accepting from the user of the client system the indication of the minimum length of time (Col 3, Lines 22-28).

23.   With regard to claim 25, Adams further discloses deleting from storage at least a portion of the received data on a first in/first out basis upon the passage of the minimum length of time indicated by the user (Col 4, Lines 3-4).

24.   With regard to claim 26, Mantha further discloses providing the user of the client system with an option to delete an earlier version of the received data being stored (any saved pages can be deleted) (Col 9, Lines 38-49).

25.   With regard to claim 29, Adams further discloses that the step of obtaining the indication of the minimum length of time occurs after the receiving step of receiving the requested data (Col 3, Lines 18-20).

26.   With regard to claim 30, Adams further discloses that the minimum length of time

received from the user is applied only to the received data (keep documents are

individually designated)(Col 3, Lines 12-16).

27.   With regard to claim 31, Adams further discloses that the client system erases

only the particular received data after the minimum length of time received from the user

(document will revert to being a non-keep document, which is deleted when the cache

fills) (Col 3, Lines 27-28 and Col 4, Lines 3-5).

28.   **With regard to independent claim 14**, Adams discloses a client, comprising:

         a central processing unit (Col 1, Lines 46-63);

         an input device coupled to the central processing unit (Col 1, Lines 46-63);

         an output device coupled to said central processing unit (Col 1, Lines 46-63); and

         a memory space operatively coupled to said central processing unit for storing

data (Col 1, Lines 46-63),

         the client being configured to temporarily store data downloaded from a network

for a minimum period of time specified by a user, after which period of time the stored

data is subject to automatic deletion(document remains a keep document for at least

the time period and only non-keep documents are deleted)(Col 3, Lines 66-67 and Col

4, Lines 3-4), said user specified minimum period of time being specified by an entry

made at said input device by the user (Col 3, Lines 22-26) after the data is downloaded

(documents which are already received may be indicated as keep documents) (Col 3, Lines 18-20);

wherein the stored data represents a particular Web site image downloaded from the network (Col 3, Lines 47-49 and 62-65) and the user-specified minimum period of time is associated with the stored data of the particular Web site image only (Col 3, Lines 6-11).

29.   With regard to claim 15, Adams further discloses that the memory space is a cache memory space (Col 3, Lines 66-67).

30.   With regard to claim 17, Adams further discloses that the client is further configured to respond to a user request to display information about the stored data (display keep status of the documents so user may delete them) (Col 4, Lines 9-15).

31.   With regard to claim 18, Adams further discloses that the client is further configured to respond to a user request to modify a property of the stored data (existing documents may be designated as keep documents) (Col 3, Lines 18-20).

32.   **With regard to independent claim 32**, Adams discloses a method comprising the steps of:

receiving, by a client system in response to a request by a user of the client

system, data for an individual Web page, from a network in a distributed system (Col 3,

Lines 47-49 and 62-65);

obtaining, by said client system from the user of the client system and after

receiving the data of the individual Web page (Col 3, Lines 18-20), an indication of a

minimum length of time during which the received data for the individual Web page is to

be temporarily stored on the client system (all documents are stored temporarily)(Col 3,

Lines 22-26); and

storing temporarily at least a portion of the received data for the individual Web

page on the client system for a period of at least the minimum length of time (Col 3,

Lines 66-67);

deleting the received data for the individual Web page from the client system

after at least the minimum length of time (after document reverts to non-keep, it will be

deleted when the cache fills)(Col 4, Lines 3-4).

Claim Rejections - 35 USC § 103

33.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

34.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et

al. (US 5,873,100) in view of Lambert et al. (US 6,038,601).

35.   With regard to claim 9, while the system disclosed by Adams shows substantial features of the claimed invention (discussed above), it fails to disclose reading an instruction provided with the received data, wherein the instruction indicates that the received data should be temporarily stored.

Lambert discloses a similar system for saving web pages on a local cache. Lambert teaches reading an instruction provided with the received data, wherein the instruction indicates that the received data should be temporarily stored (Section 3.4; Col 12, Lines 49-67). Lambert teaches that the content provider may provide an expiration date with served content, and the local cache will serve content from the local cache until the expiration date has passed. At that time, it will check with the server to determine if the content has changed. This would have been an advantageous addition to the system disclosed by Adams since it would have allowed the content provider to inform the user when the served content is likely to have changed, giving them the opportunity to check for updates if desired.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an instruction with the received data that indicates that the received data should be temporarily stored, since it would have informed the user when the content provider expects the data to have changed, giving them the opportunity to check for updates.

36.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams

et al. (US 5,873,100) in view of Blendermann et al. (US 6,789,161).

37.   With regard to claim 10, while the system disclosed by Adams shows substantial

features of the claimed invention (discussed above), it fails to disclose deleting the data

immediately after the specified minimum length of time has passed.

        Blendermann discloses a system for temporary storage of files. Blendermann

teaches allowing the user to specify that files be immediately deleted upon the passage

of their expiration time (at least Col 3, Lines 16-22). Upon passage of the expiration

time, the files will be immediately deleted. This would have been an advantageous

addition to the system disclosed by Adams since it would have improved the efficiency

of the storage space by removing the expired files.

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to delete the stored pages immediately upon expiration of

the minimum length of time since it would have freed up cache space and removed

unwanted data, increasing the number of pages that the user may store in cache.

38.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams

et al. (US 5,873,100) in view of Porter (US 6,476,827).

39.   With regard to claim 11, while the invention disclosed by Adams shows

substantial features of the claimed invention (discussed above), it fails to disclose that

the data is a first Web page containing a hyperlink to a second Web page and the

storing step includes storing data of the second Web page.

Porter discloses a similar system for saving web pages to a client. Porter teaches

traversing the hyperlinks of a first page to retrieve the pages the links point to and

saving them in addition to the original page (Col 5, Line 64 to Col 6, Line 1). This would

have been an advantageous addition to the system disclosed by Adams since it would

have ensured that pages referenced in the parent page would also be available to the

· user during the specified time period.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to include the web pages linked to by the parent web page

when saving a page at the client. Since the pages linked to by the parent page are likely

related and of interest to the user, this would have ensures that the pages linked to by

the parent page would be available to the user during the specified time period.

40.   Claims 27 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over

Adams et al. (US 5,873,100) in view of Reinhardt (US 5,680,609).

41.   With regard to claims 27 and 28, while the system disclosed by Adams shows

substantial features of the claimed invention (discussed above), it fails to disclose

notifying the user of the client system prior to deleting the received data or deleting the

data after being authorized by the user.

Reinhardt discloses a method for deleting files from a computer system.

Reinhardt teaches providing the user with the option of requiring that the user be asked for permission to delete files scheduled for deletion (at least Col 7, Lines 26-50). This would have been an advantageous addition to the system disclosed by Adams since it would have allowed the user to stop deletion of any file if they decided to keep it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to notify the user that the expiration period has expired and obtain permission to delete the expired files prior to deleting them. This would have allowed the user to stop deletion of any file that they still wanted to keep.

42.   Claims 12,34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100).

43.   **With regard to independent claim 12**, Adams discloses a method comprising the steps of:

browsing by a user at a client in order to locate Web page data associated with a specific Web page (Col 3, Lines 47-49 and 62-65);

at said client, entering a time specified by the user for the Web page data associated with the specific Web page (Col 3, Lines 22-26);

storing said Web page data for the specific Web page temporarily in a cache (all documents are stored temporarily)(Col 3, Lines 66-67);

after said user specified time period, deleting the Web page data for the specific Web page from said cache (after document reverts to non-keep, it will be deleted when the cache fills)(Col 4, Lines 3-4);

Adams fails to specifically disclose the specific ordering of the steps where the entering step is performed after the browsing step and before the storing step. Rather, Adams discloses that the entering step is performed prior to or simultaneous with the browsing step.

In the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to reverse of the order of steps in the claimed process. For example, in *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959), the BPAI held that since "It is evident therefore that no unexpected result is obtained by reversing the order of steps recited in the method ...." " the method recited in the appealed claims is not patentable over appellant's patented method." (id., at 442).

This claim is sufficiently similar to the claims at issue in *Ex parte Rubin*. In *Ex parte Rubin*, the claimed method produced a laminated sheet by laminating one side and then putting a metallic film on the other side. It was held to be unpatentable over a claim directed which placed the metallic film on one side prior to laminating the other side. In that case, the product produced was identical, regardless of the order of the steps, and performing them in either order produced no unexpected results.

In this case, the claim states that the entering step is performed after the browsing step and before the storing step. The end result of those steps is receipt of an expiration time from the user, allowing the file to be stored for the specified time. Adams

discloses that the entering step is performed prior to or simultaneous with the browsing step (Col 3, Lines 15-17), and before the storing step. The end result of Adams' steps is exactly the same; receipt of an expiration time from the user, allowing the file to be stored for the specified time. There are no unexpected results arising from reversing the order of the entering and browsing steps. Computers are quite predictable and perform only the exact instructions they are told to, and it is apparent that collecting the expiration time from the user prior to or after the browsing step will result in the same outcome, since they are completely independent operations.

Several other cases support the proposition that the ordering of steps is not patentable, absent some evidence of unexpected results. *See In re Burhans*, 154 F.2d 690, 69 USPQ 220 (CCPA 1946) (holding that the order of steps in making wheat flour is not patentable "in the absence of any proof in the record that the order of performing the steps produces any new and unexpected results"); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (holding that the order of mixing ingredients as an "obvious and practical operation"); *In re Lang et al.*, 97 F.2d 626, 38 USPQ 187 (CCPA 1938) (holding that arranging known steps in a particular order "would not amount to invention"). *See also In re Peddrick, Jr. et al.*, 48 F.2d 415, 9 USPQ 269 (CCPA 1931) (finding patentable a new arrangement of steps that produced "new and useful results", but noting that arrangements which produce obvious results are "not the result of invention").

44.   Claims 34 and 35 are rejected under the same rationale as claim 12. These

claims merely specify that the obtaining step (substantially identical to entering step of

claim 12) is performed after the receiving step and before the storing step. This would

have been obvious for at least the reasons set forth with respect to claim 12.

Conclusion

45.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aaron Strange whose telephone number is 571-272-

3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS 3/1/07

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